

## **REMARKS**

### **Status of the Application**

Claims 11, 13, 15 and 56-65 are pending in this application. Applicants herewith provisionally withdraw claims 56-59 and 63-65 pending the outcome of the Petition filed herewith.

### **Election/Restriction**

The Office Action of July 9, 2008 (hereinafter "the Office Action") is replete with errors. Applicants request that the Examiner make appropriate correction of the following errors in any subsequent communication from the Office:

- At the Office Action Summary, 4a incorrectly lists 56-61 and 63-65 as being withdrawn. The Examiner has examined claim 61 in the Office Action. As claim 61 has been examined at Applicants' request, it cannot be withdrawn. The status of claim 61 is currently labeled "Previously presented."
- At page 2 of the Office Action, the Examiner incorrectly states that Applicants elected claims 11, 13, etc. without traverse in the June 12, 2007 Reply. Applicants traversed the restriction at page 5 of the April 17, 2008 Reply, the Reply following the December 20, 2007.
- At page 2 of the Office Action, the Examiner mischaracterizes Applicant's argument. Applicants did not argue that we have cancelled 13 out of 55. Applicants noted that all but 13 of the 55 claims have been cancelled.

### **Objections to the Specification**

At page 2 of the Office Action (item 4), the Examiner objects to the abstract of the disclosure asserting that "it does not describe the elected invention" allegedly required as set forth at MPEP 608.01(b). There is no such requirement.

MPEP 608.01(b) requires that “abstract [be] directed to the technical disclosure in the specification”, not to the particular elected invention. Applicants submit that the abstract is directed to the technical disclosure of the specification in accordance with 37 CFR 1.72.

At page 2 of the Office Action (item 5), the Examiner further objects to the title of the disclosure asserting that it is not descriptive. Applicants are not aware of any law or rule that requires that the title be descriptive. Applicants request that the Examiner cite the appropriate law or rule for this supposed requirement if this objection is to be maintained. Applicants note that 37 CFR 6.02 states that the “title of the invention should be ... descriptive”. The term “should” does not make this a requirement. Even so, Applicants believe that the title of the invention is descriptive.

At page 2 of the Office Action (item 6), the Examiner further objects to the priority claim asserting that the filing date of the parent application is incomplete. Paragraph refers to the provisional’s priority date as May, 1, 2000. Applicants believe that the date is complete. If the objection is to be maintained, tell us how this date is incomplete.

#### Drawings

At page 2 of the Office Action (item 7), the Examiner further objects to the drawings asserting that they contain a number of screen prints that appear black when printed. This may be true with the original drawings; however, formal drawings were filed on July 6, 2001 with a petition to publish this application with those formal drawings. The petition was granted on February 20, 2002. The formal drawings are not screen prints and do not include the informalities found in the original drawings that the Examiner appears mistakenly to be referring to. Please identify the informalities with reference to the formal drawings and with greater specificity so that we can make the appropriate correction if necessary. For example, circle the problems areas in the formal drawings to avoid any misunderstanding.

### 35 USC 112

The Examiner rejects claims 11, 13, 15, and 61-62 under 35 USC 112, first paragraph, asserting that these claims do not comply with the enablement requirement. The Examiner alleges that claims 11 and 63 have conflicting limitations. Applicants disagree.

Claim 11 recites “displaying to said client a list comprising only said selection of wagerable event outcomes.” For example, the list may be displayed in a window, such as the available instruments window shown in Fig. 5. Claim 11’s language does not imply that the whole interface includes only those event outcomes available to the particular client. Rather, claim 11 implies that the particular list contains only those available event outcomes. Other event outcome of interest may be displayed, for example, in other windows, such as the cantor index spread betting index also shown in Fig. 5. This is explained at at least page 8, lines 16-36. As such, Applicants submit that the claims are properly enabled. Accordingly, withdrawal of the rejection is respectfully requested.

### 35 USC 103

The Examiner rejects claims 11, 13, 15, and 61-62 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,277,424 (hereinafter “Wilms”). The Examiner’s rejections are respectfully traversed.

It is well established that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *In re Oetiker*, 977 F.2d at 1445. If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993); *Novamedix Distrib. Ltd. v. Dickinson*, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference. The Examiner must support a factual finding of a suggestion or motivation to modify a reference with

substantial evidence in the record. *Novamedix Distrib.*, 175 F. Supp. 2d at 9; *In re Zurko*, 258 F.3d 1379, 1383-1386 (Fed. Cir. 2001); *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). A conclusory or common sense statement as to the factual question of motivation must be supported by evidence of record and without such evidence, lacks substantial evidence support and is thereby insufficient to establish a *prima facie* case of obviousness. *In re Lee*, 277 F.3d at 1343-1345; *In re Zurko*, 258 F.3d at 1385. *See Innogenetics*, 512 F.3d 1363, 1373-74 (Fed. Cir. 2008) (excluding obviousness testimony that was “vague and conclusory” regarding the motivation to combine references).

#### Claims 11 and 61

Claim 11 recites “displaying to said client a list comprising only said selection of wagerable event outcomes”. The selection is made based on the minimum required wager associated with particular event outcomes and the wagering limit for the client. The Examiner acknowledges that Wilms does not disclose this feature. *See* Office Action page 5. The Examiner states, however, that it would have been obvious to one skilled in the art to modify Wilms to show only the selected wagerable event outcomes in order to reduce the risk of player confusion. The Examiner has not shown that all of the elements of claim 11 are found in the prior art. The Examiner has similarly not shown any evidence in the prior art that shows user confusion with the Wilms device. The Examiner’s motivation is merely a conclusory statement without any support in the prior art.

As such, the Examiner has failed to make a *prima facie* showing of obviousness. Applicants request that the Examiner produce evidence that shows the above claim limitation and the motivation to modify Wilms as suggested by the Examiner if the rejection is to be maintained.

Claim 61 is similarly rejected without any support from the Examiner. Applicants request that the Examiner produce evidence that shows the limitations of claim 61 and the motivation to modify Wilms as suggested by the Examiner if the rejection is to be maintained

Dependent claims

The other dependent claims are allowable for the same reasons as the claims from which they depend. Applicants submit that the dependent claims are patentable for additional reasons. While deemed unnecessary to argue these additional reasons at this time, given the arguments presented above, Applicants reserve the right to present such argument, including the interpretation of any terms of the claims, should it become necessary or desirable to do so.

Conclusion

The Examiner is invited to contact the Applicants' undersigned representative at 212-829-5407 to expedite prosecution.

Respectfully submitted,

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Date

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